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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,592	04/12/2004	Jong Woo Lee	F-8162	2847
28107	7590	10/12/2006		
JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			EXAMINER SCHELL, LAURA C	
			ART UNIT 3767	PAPER NUMBER

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/822,592

Applicant(s)

LEE, JONG WOO

Examiner

Laura C. Schell

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Diaz et al. (US Patent No. 6,908,452). Diaz discloses a delivery apparatus (Fig. 1a) for medical fluids, having a flat, round, compact shape (Fig. 1a discloses that the apparatus is flat, it is round as it does not have any sharp corners and it is compact as Fig. 19 discloses that it is small enough to be worn by the patient and is portable), comprising: an outer case (Fig. 1a discloses that the outer case is defined by 10), comprising an upper case (Fig. 2b, 26) and a lower case (22), each including axially extending portions which engagingly cooperate with one another (Fig. 2b discloses two projections, one of which is close to the arrow of reference number 16, which extend downwards axially, and which engage cooperatively the axially extending portions which extend upwards better seen in Fig. 2a labeled as portion 216); an axially extending projection holder (Fig. 2a, 20), circumferentially around which a tubular body (24) is capable of being wound, said projecting holder being formed to axially extend from a center of said upper case (as element 20 is fixedly attached to the upper case (attached to portion 18 of upper case) it is therefore considered to be clearly extending upwards in the axial direction from the center of the case, especially since Applicant has not defined the projecting holder as

being integrally formed portion of the upper case); a tubular body (24) circumferentially wound against said projecting holder, said tubular body having opposite ends, both of which are wound around said projecting holder; a branch conduit (Fig. 3, 82) connected to said tubular body (Fig. 8 discloses that portions (98) of the branch conduit would be connected to the opposite ends of the tubular body); and said projection holder, said tubular body and said branch conduit each disposed within said outer case and radially spaced from said axially extending portions of said outer case (Fig. 2a clearly discloses that all components are located within the outer case and clearly they are spaced from the axially extending portions located near 216); a hose for medical fluids, extending radially through said outer case and connecting to said branch conduit within said case (Fig. 1a discloses a hose (14) with an end (172) that connects to the port as seen in Fig. 13b. Fig. 13b further shows that the narrow nozzle portion of the medical hose, as seen in Fig. 1a, actually extends into the outer case and through to connect at site (132) which is within the outer case as shown in Fig. 13a, and this connects the hose with the branch conduit through the lumen of (130)).

In reference to claim 13, Diaz discloses an intermediate ring between said upper case and said lower case (the intermediate ring can be the ring-shaped portion of the screw posts in which the screws which connect (20) to (18) are screwed into, as these are between the upper and lower case).

In reference to claim 14, Diaz discloses a plurality of axially extending fixing protrusions disposed on said branch-conduit for affixing said branch-conduit; and a corresponding plurality of axially extending fixing grooves disposed on at least one of

said upper case and said lower case, which cooperate with and fix corresponding ones of said fixing protrusions for axially fixing said tubular body within said outer case; said protrusions and said grooves being disposed within said outer case and radially spaced from said axially extending portions of said outer case. Fig. 8 discloses parallel protrusions which form a groove (close to the arrow of 82) which allows element 20 (which are the corresponding grooves of the part of the upper case) of Fig. 3 to fit within the groove and hence connect to it, wherein 20 is connected to the upper case and the parallel protrusions forming the groove near 82 are part of the branch conduit which connects to the tubular body, and hence the interconnections allow the tubular body to axially fix the tubular body within the outer case.

In reference to claim 15, Diaz discloses an injection port (Fig. 13a discloses an injection port (86)) at one end of the branch conduit; a unidirectional flow injection valve (Figs. 13a and b), in fluid communication with both said injection port and a passageway hole in said upper case (Fig. 1b, 204, 206 and 208; also see col. 21, lines 30-65).

In reference to claim 16, Diaz discloses a press-openable and closeable lid (Fig. 1b, 230) for alternatively opening and closing said passageway hole of said upper case.

In reference to claim 18, Diaz discloses that the tubular body is wound onto said projecting holder in a stretched state (Fig. 2a discloses that 24 is in a stretched state).

In reference to claim 19, Diaz discloses a recess groove formed on said branch-conduit, and wherein an affixing member is fixed by applying pressure to said recess groove (Figs. 8 discloses that the portion (98) or the branch conduit has a recess

groove and that the affixing member is a portion of (24) which is fixed by applying pressure to the groove, as seen in Figs. 11a and 11b).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diaz in view of Davis (US Patent No. 3,217,949). Diaz discloses the device substantially as claimed including the lid, however Diaz does not disclose the scored folding line or slot. Davis, however, discloses a press openable and closeable lid (Figs. 5 and 6, 20) that opens and closes over a hole. Davis also discloses that the lid has a scored folding line (Fig. 1, 23) on the exterior side of the lid, and a v-shaped slot (Figs. 3 and 5, 23) on the interior side of the lid, and a portion of the lid (Fig. 6, 14) below the scored folding line is affixed to the upper case. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Diaz with the lid of Davis, in order

to provide the infusion device with a lid to cover the opening and keep the opening clean from debris.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diaz in view of Lee (US Patent No. 6,024,724). Diaz discloses the device substantially as claimed including a recess groove (Fig. 6, groove in which 50 sits). However, Diaz does not disclose expressly a rabbet groove on the recess groove, a projecting ring on the affixing member, an incised interior side of the affixing member or the recess groove being doubly sheathed. Lee discloses a groove (Fig. 6, 262) and a projecting ring (271) on the affixing member. Lee further discloses that the affixing member is of two layers (Fig. 6) and that a portion of the affixing member (262) is incised so as to be elastically reactive (col. 8, lines 54-64). Lee further discloses that the affixing member would allow the groove to be doubly sheathed. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the recess groove of Diaz with the rabbet groove, projecting member and affixing members as taught by Lee in order to provide a very secure seal between the affixing member and the branch conduit.

### ***Response to Arguments***

Applicant's arguments with respect to claims 12-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Schell whose telephone number is (571) 272-7881. The examiner can normally be reached on Monday-Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LCS

*LCS*

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

*Kevin C. Sirmons*